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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

826.1797

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on November 12, 2008

Signature

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Application Number

10/082,112

Filed

February 26, 2002

First Named Inventor

Seijun Tanakawa

Art Unit

2455

Examiner

Philip B. Tran

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number

- ☐ attorney or agent acting under 37 CFR 1.34.

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November 12, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- ☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Reasons for Requesting Review

A. Claims 1, 11, and 15 are patentable over Nobakht, as Nobakht fails to disclose each and every element of the claims.

1. Background of the Reference on which the Rejection is Based

Nobakht is directed to a channel-based network for accessing the Internet. According to Nobakht, the network includes a system server, one or more Internet sites and one or more user terminals that are connected via the Internet. The system server stores a master channel table that includes a list of channel numbers, each channel number having an associated Internet address and an associated Internet site name. Each Internet site of the network is addressable by an associated Internet address stored in the master channel table.

Each user terminal automatically (that is, without user participation) downloads and stores a local copy of the master channel table. The channel numbers and associated Internet site names are read from the downloaded local copy of the channel table and displayed, for example, on a television in a menu-like manner. The user selects an Internet site name from the displayed menu and enters the channel number associated with the selected Internet site name using an input device that is similar to a television remote control. The user terminal then accesses the selected Internet site name using an input device that is similar to a television remote control. The user terminal then accesses the selected Internet site by reading the Internet address associated with the entered channel number and transmitting the Internet address onto the Internet. See Nobakht, Abstract. The user terminal in Nobakht includes a remote control and wireless keyboard, which are capable of providing Unicode symbols to set-top box 131. See Nobakht, FIG. 1.

Nobakht performs site connection by a user terminal selecting a channel number instead of URL input. Nobakht facilitates the connection with the Internet sites. More specifically, a user terminal downloads from a system server, data in a channel table comprising URL's associated with channel numbers and site names. After a channel number is selected from an input device of the user terminal, the terminal accesses the associated Internet site.

2. Relevant Law

By its language, 35 U.S.C. § 102 requires that each and every element of a claim be present in a single cited reference to properly have the reference anticipate the claim. See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566, 1567 (Fed. Cir. 1992), citing *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485

(Fed. Cir. 1984); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992); and *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 36 USPQ2d 1417, 1419 (Fed. Cir. 1995).

3. Application of the Relevant Law

Appellants respectfully submit that claims 1, 11, and 15 are patentable over Nobakht, as Nobakht fails to disclose:

An IA terminal user storing unit storing IA terminal information including an IA terminal identifier for identifying a number or mark of a manufacturer of the IA terminal, service information including the kind of service to be received, and user registration information including user information concerning the user who receives the service, said IA terminal information representing registration information required for an Internet connection.

See present application, claim 1. Claim 1 clearly recites "An Internet appliance (IA) terminal user management system. . . ." As is illustrated in FIG. 1, the Internet Appliance Terminal User Management System 3, a server, is connected to the Internet Appliance Terminal 1, a client. Therefore, the IA terminal user storing unit is provided in the server. The information identified at column 6, line 37 – column 7, line 36 of the reference by the Examiner relates to the terminal 130-A, not a server.

In addition, the description of the reference at column 6, line 45 – column 7, line 36 and column 8, lines 1-41 regarding the user registration information collation unit does not describe or suggest that the registration information is input as needed, on the basis of the information received from the IA terminal, as in the present invention.

Appellants further submit that the reference fails to disclose the automatic registration unit of the present invention. For example, in contrast to the present invention, column 8, lines 1-15 of the reference describes that authentication is conducted while acquiring USER ID from smart card 232 by set-top box 131, which is also a function of a terminal and different from the function in the present invention for the automatic registration of registration information needed for the Internet connection of terminal devices.

Further still, Appellants respectfully submit that claim 1 is patentable over the reference, as the reference fails to disclose, "a transmission and receiving unit on the side of the IA terminal user management system, transmitting and receiving the user registration information to and

from the IA terminal, and requests the IA terminal to input the user registration information," as recited in, for example, claim 1.

Appellants respectfully submit that Nobakht's remote control 202 and wireless keyboard 203 are not "on the side of the IA terminal user management system," as in the present invention. Nobakht clearly indicates that both the remote control 202 and the wireless keyboard 203 are on the side of the *user terminal* 130-A, not on a side of an IA terminal user management system. See FIG. 2, which, according to Nobakht, is a "block diagram showing a *user terminal* of the channel-based network. . . ." See also column 2, lines 49-51. Further, Nobakht clearly states that each input device must be capable of providing Unicode symbols to set-top box 131, which is on the side of the *user terminal*, not on a side of an IA terminal user management system. See FIG. 1.

Further still, the input devices in Nobakht do not receive user registration information from an IA terminal. That is, in Nobakht, a user management system is not provided that includes a transmission and receiving unit that receives user registration information from an IA terminal. The input devices merely provide symbols to a set-top box on the side of the user terminal, not the server 110. See FIG. 2 and FIG. 1 (clearly depicting the set-top-box 131 as a part of the user terminal 130-A). Moreover, one of ordinary skill in the relevant art would readily appreciate that input devices such as those identified above input data and do not receive data.

The Examiner also alleged that Nobakht discloses an IA terminal identifier for identifying a number or mark of a manufacturer of the IA terminal, service information including the kind of service to be received, and user registration information including user information concerning the user who receives the service.

Appellants respectfully submit that Nobakht does not disclose the above-identified information. For example, Nobakht merely indicates that network database 416 stores "user and terminal information used to identify and authorize users that request service." Therefore, such information identifies and authorizes *users* that request service. Therefore, in contrast to the present invention, the information disclosed in Nobakht does not identify a number or mark of a manufacturer of the IA terminal, as the Nobakht information simply identifies a user requesting the service.

Although the update manager database 418 of Nobakht stores terminal information, no information is provided regarding a number or mark identifying the manufacturer of the terminal. For example, the terminal information of Nobakht could simply indicate a MAC address for the terminal, which is not a number or mark identifying the manufacturer.

Moreover, Appellants respectfully submit that Nobakht clearly indicates that each user terminal automatically downloads and stores a local copy of the master channel table from the server. Therefore, in contrast to the present invention, the server of Nobakht does not receive user registration information to and from an IA terminal, as the user terminal in Nobakht simply receives the download information and does not transmit any information to the server, much less user registration information. See Nobakht, column 3, lines 43-45.

As the server of Nobakht does not receive any information, Nobakht does not collate received information with stored information as in the present invention. Appellants respectfully submit that it should be understood that Nobakht's user terminals simply serve as a mechanism for allowing a user to connect his or her terminal to a desired Internet site. To accomplish the task, the user terminal receives data downloaded from the server. The data matches channel numbers to Internet sites. See Nobakht, column 3, lines 43-50.

Therefore, claims 1, 11, and 15 are patentable over the reference. As dependent claims 2-8 and 12 depend from independent claims 1 and 11, respectively, the dependent claims are patentable over the references for at least the reasons presented for the independent claims.

B. Claims 9, 13, and 16 are patentable over Nobakht, as Nobakht fails to disclose each and every element of the claims.

1. Relevant Law

By its language, 35 U.S.C. § 102 requires that each and every element of a claim be present in a single cited reference to properly have the reference anticipate the claim. See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566, 1567 (Fed. Cir. 1992), citing *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675,677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992); and *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 36 USPQ2d 1417, 1419 (Fed. Cir. 1995).

2. Application of the Relevant Law

Appellants respectfully submit that claims 9, 13, and 16 are patentable over Nobakht, as Nobakht fails to disclose:

A transmission and receiving unit on the side of the IA terminal, transmitting and receiving IA terminal information including an IA terminal identifier for identifying a number or mark of a manufacturer of the IA terminal, service information including the kind of service to be received, and user registration information including user information concerning the user who receives the service to and from the IA terminal user management system which manages the IA terminal via the network, said IA terminal information representing registration information required for an Internet connection.

On page 6 of the Office Action, the Examiner cites column 6, line 37 – column 7, line 36 and column 8, line 1 to column 9, line 3 and column 10, lines 10-26 of the reference for allegedly disclosing the above-identified feature of the present invention.

Appellants respectfully submit that the cited sections do not disclose the transmission and reception of IA terminal information including an identifier identifying a number or mark of a manufacturer of the IA terminal and service information including the kind of service to be received, for example. In contrast to the present invention, Nobakht simply discloses a customer number and a personal identification number. The personal identification number identifies a customer, and as such, does not represent an identifier identifying a number or mark of a manufacturer. See Nobakht, column 6, lines 45-49. Moreover, the sections fail to disclose the registration information needed for the Internet connection.

Further, Nobakht fails to disclose “an input unit inputting insufficient user registration information based on the request of the IA terminal user management system and writing the user registration information in a user storing unit of the IA terminal,” as recited in, for example, claim 9.

Although Nobakht discloses a keyboard and a remote control, the devices simply provide symbols to a set-top box on the side of the user terminal and do not input user registration information based on a request of a server.

In light of the foregoing, claims 9, 13, and 16 are patentable over the references.